

**REMARKS****I. Continuing Obligation Under 37 CFR 1.178(b)**

There are no concurrent proceedings involving United States Patent No. 5,897,307, upon which this reissue application is based. The '307 patent was previously the subject of litigation in the United States District Court for the Central District of California, Case No. 03-576, which has since been settled.

**II. Response to Rejection of Claims**

Examiner has rejected claims 1, 4, 7, 10-13, and 17 pursuant to 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,597,299 to Jon ("Jon") in view of U.S. Patent No. 5,096,414 to Zellweger ("Zellweger").<sup>1</sup>

In accordance with the Manual of Patent Examining Procedure (MPEP):

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on the applicant's disclosure. *In re Vaack*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

*See* MPEP § 2142. Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching, suggestion or incentive supporting the combination. *See* MPEP § 2143.01. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, *and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art.*" *See id.* (emphasis

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<sup>1</sup> In addition, claims 2, 3, 5, 6, 8, 9, 14 and 15 were objected to as being dependent on rejected base claims, but would be allowable if rewritten in independent form to include all the limitations of the base claims.

added), citing *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000); *In re Lee*, 277 F.3d 1338, 1342-44, 61 USPQ2d 1430, 1433-34 (Fed. Cir. 2002) (discussing the importance of relying on objective evidence and making specific factual findings with respect to the motivation to combine references). Moreover, “[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).” (emphasis in original).

Here, Examiner asserts that Jon teaches all the limitations of the claimed invention, except that “Jon does not disclose that the wind shield includes two protecting bent-edge members that cover the gaps formed between the striking wheel and the first and second supporting walls.” See Office Action at ¶4. As to this element, Examiner asserts that Zellweger discloses a lighter having “[a] wind shield portion (9) [that] surrounds the striker wheel and discs and includes two bent edge members (12 and 13) that are inwardly extended (see Fig. 3).” See Office Action at ¶4. According to Examiner, “[t]he edges are provided as a child safety feature in preventing a child’s finger from being able to access the striker wheel (see col. 2, lines 12-23).” See Office Action at ¶4. Examiner concludes, therefore, that “it would have been obvious to a person of ordinary skill in the art at the time of the invention was made to modify the lighter of Jon to incorporate the bent edge portions taught in Zellweger for the desirable purpose of forming a child safety arrangement that restricts the ability of a child’s finger from coming into contact with the ignition mechanism (see Zellweger, col. 2., lines 12-30).” See Office Action at ¶4. Applicant respectfully traverses the rejection of the claims for the following reasons.

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### 1. No Motivation to Combine

As recited above, it is a basic rule of § 103 that “the prior art reference (or references when combined) must teach or suggest all the claim limitations.” *See* MPEP § 2142. Also, “the reference teachings must somehow be modified in order to meet the claims. The modification must be one which would have been obvious to one of ordinary skill in the art at the time the invention was made.” MPEP §706.02(a); *see also, In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998) (holding that, although the combination of the references taught every element of the claimed invention, without a motivation to combine, a rejection based on a *prima facie* case of obviousness was improper).

Applicant submits that the references do not teach all the claim limitations and, moreover, there could not have been any motivation to combine the references based on the teachings of the prior art. Specifically, Zellweger does not teach a lighter having a wind shield wherein “a top end corner of each of said wing portions forming a curved corner which has a curvature matching with at least a quarter of a circumference of said striking wheel, so that said striking wheel is sidewardly covered by said two wing portions of said windshield,” as claimed in the reissue application. *See* claim 1 of Application. Nor does Zellweger teach a lighter having a wind shield “wherein said first and second bent-edge members of said wind shield are respectively and inwardly extended until abutting two sides of said striking wheel...” *See id.* Hence, the assertion by Examiner that in Zellweger “[t]he edges [12 and 13] are provided as a child safety feature in preventing a child’s finger from being able to access the striker wheel (see col. 2, lines 12-23)” in a manner as claimed by Applicant is incorrect because Zellweger simply does not teach either of the above recited elements, and there is also no motivation to combine Zellweger with Jon.

i. **The curvature element**

There is nothing in Zellweger as referenced by Examiner at column 2, lines 12-23, that would support the assertion that the edges (12 and 13) provide a child safety feature in the same manner as claimed by Applicant's invention. In fact, given the operating principle underlying the safety feature embodiment in Zellweger, it is clear that Zellweger teaches away from the use of the wind shield to protect the strike wheel:

...the lighter comprises a flame guard 9 as previously described, but **the height of this latter is greater than that of the striker wheel 6** and the two edges 12 and 13 of this flame guard are formed so as to come into the immediate proximity of the wheel 6. The flame guard 9 surrounds, in a known manner, a burner 14 for the outlet of gas. The same phenomenon is employed in this second embodiment as in the preceding, namely, **the pulp of the finger of an adult may come into contact with the wheel 6, whereas the pulp of the finger of a child does not reach there.**

See Zellweger, Col. 2, ll. 19-23 (emphasis added). In Zellweger, the guard is thus raised above the strike wheel, the purpose and effect of which is to make the strike wheel *recessed* between the edges 12 and 13 of the flame guard 9, such that contact between thumb and wheel is minimized. The operating assumption as expressly set forth by Zellweger is that if the strike wheel is recessed, it would be harder for children to actuate the strike wheel given that children have less "pulp."<sup>2</sup>

This is in complete contrast to the safety feature of the claimed invention, which is based on *protecting* the strike wheel with the wind shield to inhibit accidental actuation of the wheel.

The specification of the claimed invention provides:

...the striking wheel 52 of the disposable lighter of the present invention is arranged to **match the curvature of the curved corners 631, 641 of the wind shield 60. In other words, the striking wheel 52 is protected by the wind shield 60 also, so that the striking wheel 52 can only be ignited**

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<sup>2</sup> The assumptive principle that children have less "pulp" than adults underlies the safety design in both the first and second embodiments of Zellweger.

by the user's thumb on purpose and can prevent the striking wheel 52 from being rubbed with any object to accidentally ignite. Furthermore, in the past, an underage kid can easily ignite a conventional gas lighter by rubbing the protruding driving wheel A32, A33, as shown in FIG. 1, with limited force. However, the underage kid is prevented to ignite the present invention since his or her weak minor's thumb force is unable to apply a sufficient striking force to the striking wheel 52 of the present invention without any adult supervision. (Col. 5, lines 39-53).

The strike wheel is thus protected by the wind shield as the curvatures of the corners 631, 641 substantially match the curvature of the strike wheel.

On this point, Examiner comments that:

In regard to the recitation in the claims as to the radius of the curved edges of the wind shield compared to the striker wheel, the radii shown and the size relationship to the striker wheel shown in Jon in applicant's Figures [sic] and is considered to meet the limitations of the claims. Alternatively, the radius of the wind shield curvature shown in Jon appears to be slightly less than that of the striker wheel (see Fig. 5). Whereas in Zellweger, the radii are equal (see Fig. 2). It would be obvious to a person of ordinary skill in the art at the time the invention was made to select equal radii as this radii is well recognized in the art when selecting a wind guard that extends above the striker wheel.

Applicant respectfully disputes the contention that Figure 2 of Zellweger shows that the radii of the strike wheel and of the corners of the windshield are equal. First of all, no mention whatsoever is made in Zellweger as to the wing portions forming a curved corner having a curvature matching a quarter of the circumference of the striking wheel, so that the striking wheel is sidewardly covered by the two wing portions of the windshield. More importantly, the Zellweger specification teaches that "the height of this [flame guard 9] is greater than that of the striker wheel 6 and the two edges 12 and 13 of this flame guard are formed so as to come into the immediate proximity of the wheel 6." If in Zellweger the height of the flame guard is greater than that of the strike wheel, then it follows that the wing portions cannot form a curved corner having a curvature matching with at least a quarter of the circumference of the striking wheel.

As can be seen in Figures 4 and 7 of the specification of the reissue application, the elevation of the circumferential face of the strike wheel is in substantial alignment with the elevation of the wind shield, in contrast to Zellweger.

Nonetheless, Examiner asserts that “[i]t would be obvious to a person of ordinary skill in the art at the time the invention was made to select equal radii as this radii is well recognized in the art when selecting a wind guard that extends above the striker wheel.” See Office Action at ¶4. The MPEP requires, however, that an objective source be provided to support a contention that a feature is known or obvious to one skilled in the art. An unsupported statement that a feature or combination “would have been obvious to one skilled in the art” is improper if made without support. *In re Garrett*, 33 BNA PTCJ 43 (November 13, 1986). And:

A statement that modifications of the prior art to meet the claimed invention would have been “well within the ordinary skill of the art at the time the claimed invention was made because references relied upon teach that all aspects of the claimed invention were individually known in the art” is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references. *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993)... [See also] *Al-site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999) (The level of skill in the art cannot be relied upon to provide suggestion to combine references).

See MPEP § 2143.01.

In sum, there is no objective basis for the contention that Zellweger can be combined with Jon to teach or suggest all the claim limitations. Zellweger teaches a safety feature based on the operating assumption that children have less “pulp” than adults, and as such the strike wheel is to be recessed between the wind shield to minimize contact. Thus, it would not have been obvious to one of skill in the art to understand Zellweger to teach the curvature of the wing portions to match the curvature of the strike wheel. In fact, given the operating assumption set forth in Zellweger, it is clear that Zellweger teaches away from the claim limitation that the

curvature of the wing portions match the curvature of the strike wheel. Therefore, the claims cannot be rejected as obvious on this ground.

**ii. The abutting sides element**

The obviousness rejection is also improper on the ground that that the bent-edge members of the wind shield in Zellweger do not inwardly extend to abut the two sides of the striking wheel to form two protecting bent-edge members. There is absolutely no teaching in the Zellweger specification that the wind shield portion (9) is to extend inward to abut the two sides of the strike wheel, as evidenced by both Figures 1 and 3 of Zellweger, in which it is clear that the bent-edge members do not abut the sides of the strike wheel. This is consistent with the teaching of the Zellweger specification that, "the height of [flame guard 9] is greater than that of the striker wheel 6 and the two edges 12 and 13 of this flame guard are formed so as to come into the immediate proximity of the wheel 6." *See Zellweger*, Col. 2, lines 14-17. Since the height of the wind shield is to be greater than the strike wheel, the wind shield cannot extend inward to abut the strike wheel.

As such, the references cited by Examiner do not teach all the limitations of the claimed invention. And given the teaching of Zellweger, it would not have been obvious to one of skill in the art to combine the references as suggested by Examiner.

### CONCLUSION

The Examiner is respectfully requested to reconsider his position in view of the remarks made herein. It is believed that this application—specifically, claims 1, 4, 7, 10-13, and 17 (and also the dependent claims therefrom)—have been placed in condition for allowance, and such action is respectfully requested.

If the Examiner believes that a telephone or other conference would be of value in expediting the prosecution of the present application, enabling an Examiner's amendment or other meaningful discussion of the case, Applicant invites the Examiner to contact Applicant's representative at (310) 777-8399.

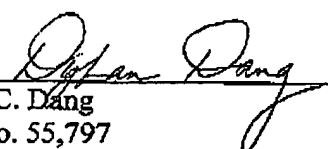
If any additional fees are required as a result of this amendment, or any credit needs to be made for overpayment of fees, the Commissioner is hereby authorized to charge such fees to Deposit Account No. 500703.

Respectfully submitted,

TROJAN LAW OFFICES

By

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